

REMARKS

In response to the office action dated March 13, 2007, wherein claims 1, 2, 6 and 7 were rejected as being obvious over U.S. Patent No. 4,495,518 Sanoian in view of Donskoy, Applicant has amended the claim to more clearly define the invention. The claims have been amended according to the inventive concepts discussed in the personal interview dated April 12, 2007, between Examiner Mirellys Jagan and Susan Fentress where claims 1, 2 and 6 were discussed with respect to the differences between the Sanoian reference and the claimed invention.

Federal Circuit has explicitly addressed § 103 and followed the approach this Court set forth for applying that provision. Section 103 provides, in pertinent part:

A patent may not be obtained...if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. 35 U.S.C. § 103(a).

The Supreme Court in *Graham* held that:

While the ultimate questions of patent validity is one of law, the § 103 condition, which is but one of three conditions, each of which must be satisfied, lends itself to several basic factual inquiries. Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy.

Graham v. John Deere, Co., 383 U.S. 1 (1966).

Thus, under *Graham*, the obviousness inquiry is highly fact specific, and requires an examination of the following: (1) the scope and content of the prior art; (2) the differences between the patented invention and what already existed in the prior art; (3) the ordinary level of skill of people working in the field; and (4) other objective evidence which may suggest that the invention would not have been obvious. The Court also warned lower courts to "guard against slipping into use of hindsight,"...and to resist the temptation to read into the prior art the

teachings of the invention in issue." 383 U.S. at 36. See also *Ashland Oil, Co. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 291 (Fed. Cir. 1985), *cert. denied* 475 U.S. 1017 (1986).

Moreover, the Federal Circuit's so-called "teaching-suggestion-motivation" standard for obviousness is fully consistent with *Graham* and its progeny. Under that standard, there must be some motivation or suggestion to combine specific prior art in such a way as to arrive at the particular combination disclosed in the patent at issue. See, e.g., *Ecolocchem, Inc. v. Southern California Edison Co.*, 227 F.3d 1361, 1372 (Fed. Cir. 2000), *cert. denied*, 532 U.S. 974 (2001)¹; *Ashland Oil*, 776 F.2d at 293. Importantly, as *Graham* instructed, the injection of hindsight in evaluating obviousness must be avoided; the requirement of a suggestion to combine prior art prevents hindsight reconstruction by accused infringers who try to use the patent-in-suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. See, e.g., *Yamanouchi Pharmaceutical Co., Ltd. v. Danbury Pharmacal, Inc.*, 231 F.3d 1339, 1343 (Fed. Cir. 2000) ("the suggestion to combine requirement stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness."); *Ecolocchem*, 227 F.3d at 137-72 ("Combining prior art references without evidence of a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability –the essence of hindsight.") (citations omitted); *Grain Processing Corp. v. American Maize-Products Co.*, 840 F.2d 902, 907 (Fed. Cir. 1988).

The rejections of pending claims 1, 2, 6 & 7 as unpatentable under 35 U.S.C. § 103(a) are respectfully traversed, since a *prima facie* case of obviousness has not been made by the Examiner. To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), each of three requirements must be met. First, the reference or references, taken alone or in combination, must teach or suggest each and every element recited in the claims. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must "be found in the prior art, and not be based on applicant's disclosure." (See M.P.E.P. § 2143 (8th Ed. 2001)). Applicant submits that these requirements have not been met for at least the following reasons:

¹ Teleflex notes that this Court denied certiorari in *Ecolocchem*. Indeed, as discussed below, the petition for a writ of certiorari in *Ecolocchem* is virtually identical to KSR's Petition in this case.

Applicants' invention relates to residential structure and the claimed method is used to confirm active termite infestation. Sanoian relates to telephone poles that have past structural damage. Moisture is retained in the structurally damaged portions of the pole and can be detected by infrared examination. The technical problem solved by Sanoian is unrelated to the present method involving a residential structure and active termite infestation. Sanoian in fact teaches away from the presently claimed method in that it requires structural damage to be operative. In the present method, active termite infestation can be detected prior to structural damage, as termites carry moisture. This moisture can be detected.

CONCLUSION

Applicants respectfully submit that the pending claims are now in condition for allowance.

Respectfully Submitted,

Butler, Snow, O'Mara, Stevens &
Cannada, PLLC

May 3, 2007
Date

By: Susan B. Fentress
SUSAN B. FENTRESS
Reg. No. 31,327
6075 Poplar Avenue, Suite 500
Memphis, TN 38119
(901) 680-7319